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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

043082

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Application Number

10/517,377

Filed

December 10, 2004

First Named Inventor

Takayuki FURUTA

Art Unit

3664

Examiner

Mingjen Jen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record. 44,450
Registration number _____☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

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Typed or printed name

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Telephone number

July 23, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Takayuki FURUTA et al.**

Art Unit: **3664**

Application Number: **10/517,377**

Examiner: **Mingjen Jen**

Filed: **December 10, 2004**

Confirmation Number: **4713**

For: **WALKING MOBILE SYSTEM, ITS WALK CONTROLLER AND WALK
CONTROL METHOD THEREFOR**

Attorney Docket Number: **043082**

Customer Number: **38834**

PRE-APPEAL BRIEF – REQUEST FOR REVIEW

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

July 23, 2008

Sir:

This request is being filed concurrent with a Notice of Appeal in compliance with 37 C.F.R. §41.31. Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this Request.

REMARKS

Claims 1-12 are currently pending in the application. Claims 1-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Takenaka in view of Yamajima. Applicants respectfully submit that the Examiner has made a clear error in asserting that the combination of Takenaka and Yamajima discloses the limitations of independent claims 1, 5 and 9 as maintained in the Final Office Action dated March 24, 2008 (referred to as “the Final Action”).

Disclosure of Takenaka and Yamajima

With regard to independent claims 1, 5 and 9 regarding the subject matters of “*the force sensors provided to the regions next to end edges of respective soles detect a contact of foot*”

sides” and “*the compensation part adjusts the gait data from the gait forming part, referring to the contact of foot sides,*” the Examiner alleged that touchdown switches 38 of Takenaka mainly corresponded to these features (e.g., see page 3, lines 10-14 of “the Final Action”). However, Takenaka is unrelated and silent regarding “*the contact of the foot side*” (see page 2, ¶4 to page 3 of the Response filed on June 17, 2008 (referred to as “the Response”).

Moreover, with regard to independent claims 1, 5 and 9 regarding the subject matters of “*wherein the foot portion includes an upper sole and a lower sole, and the force sensor is provided between the upper sole and the lower sole, and wherein the lower sole is provided with a side wall rising upward at a part next to the outer edge of the foot portion,*” the Examiner alleged that Yamajima disclosed these features (e.g., see page 3, lines 18-20 of “the Final Action”). However, Yamajima is silent regarding “*wherein the lower sole is provided with a side wall rising upward at a part next to the outer edge of the foot portion*” (see page 4, ¶2 to page 5, ¶1 of “the Response”). This is also admitted by the Examiner because the Examiner needed to modify the disclosure of Fig. 1 of Yamajima by turning upside down the weighing machine in order to support his/her rejection (see page 6, ¶1-2 of “the Response”). Therefore, it is respectfully submitted that the combination of Takenaka and Yamajima fails to disclose the limitations of independent claims 1, 5 and 9.

Failure of establishing a *prima facie* case of obviousness

The Examiner alleged the modification of the disclosure of Fig. 1 of Yamajima wherein a weighing machine of Fig. 1 of Yamajima is turned upside down such that a platform 11 will be

located at the bottom of the machine (see page 6, ¶1-2 of “the Response”). However, such alleged modification of the Examiner renders the disclosure of Yamajima inoperable for its intended purpose, which conflicts with *In re Gordon* (see page 6, ¶3 of “the Response”). Also, Yamajima teaches away from such modification.

Specifically, a platform 11 positioned at the upper surface of the weighing machine has a window 12 through which scales (a height scale 28 and a weight scale 30) are read. Therefore, if the weighing machine is turned upside down as modified by the Examiner, the window 12 cannot be read, and thus the machine would be inoperable for its intended purpose (see page 7, ¶3 of “the Response”).

Moreover, the weighing machine of Yamajima includes lamps 15-17 on the upper surface of the machine as shown in Fig. 1. These lamps 15-17 are provided for indicating whether the measured weight is optimum or not and the degree of over or under weight. Therefore, if the machine is turned upside down as modified by the Examiner, the lamps 15, 16 and 17 cannot be seen, and thus the machine would be inoperable for its intended purpose of indicating whether the weight of a weighed person is optimum for his or her height (see page 8, ¶1 of “the Response”).

Furthermore, the weighing machine of Yamajima includes a knob 25 projecting from the upper surface of the platform 11 as shown in Fig. 1. The knob 25 is provided for adjusting the height scale ring 24 to indicate the height of the measured person. Therefore, if the machine is turned upside down as modified by the Examiner, the knob 25 would be broken, or at least

cannot be rotated. Thus, the machine would be inoperable for its intended purpose (see page 8, ¶2 to page 9, ¶3 of “the Response”).

Moreover, Yamajima teaches away from the alleged modification because the disclosure of Yamajima does not allow for such modification as discussed above. Furthermore, Yamajima is non-analogous art. In other words, Yamajima relates to a field of weighing machine that is far different from a field of walking robot (see also page 9, ¶3 of “the Response”). Accordingly, it is respectfully submitted that the Examiner failed to establish a *prima facie* case of obviousness.

Advisory Action

In the Advisory Action dated July 1, 2008 (referred to as “the Advisory Action”), the Examiner asserted that the proposed amendments filed after a final rejection will not be entered because they raise new issues (see page 1, items 3 and 7 as well as page 2, NOTE of “the Advisory Action”). However, it is respectfully submitted that the Applicants have not filed any claim amendments after “the Final Action.” Therefore, it was a clear error made by the Examiner.

The Examiner alleged that the Applicant’s argument regarding upper/lower sole is not persuasive since it would be obvious for one skilled in the art to provide the force measuring tool as mentioned in the reference to the application at the time of the invention since both the reference/application are utilizing a force sensor/transducer means to measure force exerted by body torso toward the force sensor/transducer and further processing corresponding data (see page 2, NOTE of “the Advisory Action”).

In other words, the Examiner appears to allege that the present claimed invention can be obtained by simply utilizing the force measuring tool of Yamajima. However, it is respectfully submitted that the Examiner's rationale for the rejection was not based on simple utilization of the weighing machine of Yamajima. Rather, it was based on the modification of the disclosure of Yamajima, which rendered Yamajima inoperable and from which Yamajima taught away. Accordingly, it is submitted that the Examiner's allegation in "the Advisory Action" did not support the Examiner's position. Therefore, it was a clear error made by the Examiner.

If there are any fees due in connection with the filing of this paper, please charge Deposit Account No. 50-2866.

Respectfully submitted,

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